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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/544,089	07/28/2005	Hidenari Yamagata	10921.343USWO	8591

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HAMRE, SCHUMANN, MUELLER & LARSON, P.C.  
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MINNEAPOLIS, MN 55402-0902

EXAMINER
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JARRETT, LORE RAMILLANO

ART UNIT	PAPER NUMBER
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1797

MAIL DATE	DELIVERY MODE
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07/07/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/544,089	<b>Applicant(s)</b> YAMAGATA ET AL.	
	<b>Examiner</b> LORE JARRETT	<b>Art Unit</b> 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) 26-29 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☒ Claim(s) 21 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/28/05 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/28/05</u> .   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election of Group I (claims 1-25) in the reply filed on 4/9/09 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 26-29 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 3/9/09.

### ***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 7/28/05 is acknowledged. Accordingly, the information disclosure statement is being considered by the examiner.

### ***Priority***

4. Receipt is acknowledged of papers (PCT/JP04/00724 and Japan 2003-023079) submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### ***Claim Objections***

5. Claim 21 is objected to because of the following informalities: there needs to be a space between "claim" and "20." Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. The claims are generally narrative and indefinite, failing to conform with current U.S. practice. They appear to be a literal translation into English from a foreign document and are replete with grammatical and idiomatic errors.

8. Claims 1-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is vague and indefinite as to what structure is intended by reciting a "test tool." This language is sufficiently broad to be read on just about any element. For examination purposes, the recited, "test tool" be interpreted as type of analytical testing element.

### ***Drawings***

9. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the claimed "movable member" in claim 6 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the

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remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### **Claim Interpretation**

10. As to the pending claim(s) below, which contain intended use terms, the Examiner will interpret these claims in light of the structural elements that are disclosed and not for their intended use as stated after the term "for." The term, "for," is an intended use term. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

The Examiner has applied references, which are capable of meeting these functions. A structure, which is capable of providing the intended use, is considered to meet the limitation of intended use recited in a claim to a device or an apparatus.

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. **Claims 1-5 and 20** are rejected under 35 U.S.C. 102(b) as being anticipated by Blümel et al. ("Blümel," US 4279514, cited by applicant)

As to claim 1, Blümel discloses a test tool feed comprising: a storage portion for storing a plurality of test tools; a transporting member provided with at least one loading portion for loading a test tool stored in the storage portion, the transporting member transporting test tools one by one; wherein the storage portion includes a plurality of storage spaces each storing a plurality of test tools (i.e. col. 7, line 48 to col. 8, line 23; col. 9, line 27 to col. 10, line 32).

As to claims 2-4 and 20, these claims are considered statements of intended use (see Claim Interpretation paragraph above).

As to claim 5, Blümel discloses a rotating member (i.e. drum, 1, figs. 1-2).

13. **Claims 1-25** are rejected under 35 U.S.C. 102(b) as being anticipated by Bonner et al. ("Bonner," US 5510266).

As to claim 1, Bonner discloses a test tool feed comprising: a storage portion for storing a plurality of test tools; a transporting member provided with at least one loading portion for loading a test tool stored in the storage portion, the transporting member transporting test tools one by one; wherein the storage

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portion includes a plurality of storage spaces each storing a plurality of test tools (i.e. col. 5, line 29 to col. 6, line 49).

As to claims 2-4, 8-11, 14, 16, 18-20, and 23-25, these claims are considered statements of intended use (see Claim Interpretation paragraph above), and therefore do not appear to positively recite structural features.

As to claim 5, Bonner discloses a rotating member (i.e. 26, figs. 1-14).

As to claims 6 and 21, Bonner discloses a movable member capable of performing the claimed intended use (i.e. 28, figs. 1-14).

As to claims 7 and 22, Bonner discloses that her movable member includes at least one pivotable lift portion (i.e. any portion of 28), and the rotating member includes a recess (i.e. 54, figs. 1-14) capable of performing the intended use.

As to claims 12 and 17, Bonner discloses first and second storage spaces (i.e. figs. 1-14).

As to claim 13, Bonner discloses a partition member in the storage portion that separates the first and second storage spaces (i.e. see figs. 1-14).

As to claim 15, Bonner discloses that her rotating member is capable of performing the intended use language, and a rotation controller (i.e. 84, figs. 1-14).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LORE JARRETT whose telephone number is (571)272-7420. The examiner can normally be reached on Mon. to Fri.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571) 272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/LORE JARRETT/  
Examiner, Art Unit 1797

7/2/09